

REMARKS

Claims 1-3, 5-8, 10-12 and 14-19 are currently pending and have been rejected.

Independent claims 1, 6, and 11 previously required that the hard handoff is performed when the mobile station reaches a border for a hard handoff region, the hard handoff region a portion of the second wireless network. These claims have been amended to add a limitation, but also to remove the “border” requirement. The Examiner’s interpretation of this previous limitation was to ignore the “border” requirement, and read the claim as simply requiring that the mobile station reaches (or is within) a hard handoff region. The removal of the “border” limitation is to ensure that the actual language of the claims reflects the interpretation by which the claims are being examined.

The independent claims are also amended to specify that the hard handoff occurs when a hard handoff threshold has been exceeded, as described in the specification.

CLAIM REJECTIONS -- 35 U.S.C. § 102

Claims 1-3, 6-8, 11-12 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,011,971 to Jolma. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-67 (8th ed., rev. 5, August 2006) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every

limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Independent claims 1, 6, and 11 previously required that the hard handoff is performed when the mobile station reaches a border for a hard handoff region, the hard handoff region a portion of the second wireless network. As noted above, the “border” requirement has been removed from these claims.

The Examiner indicates, with relation to these limitations, a reliance on Jolma’s col.5, lines 35-39 and 50-53:

The cell 41 is served by two overlapping base stations, BTS11 and BTS21. BTS11 is coupled to base station controller BSC1, and BTS21 is coupled to base station controller BSC2. ... The terminal equipment carries out a hard handover from the base station BTS11 to the base station BTS21, and consequently, the base station controller change from BSC1 to BSC2 takes place.

It is clear that neither these passages, nor any other part of Jolma. define or describe a “hard handoff region”, as claimed, or that it is a portion of the second wireless network. The Examiner appears to allege that Jolma defines a “hard handoff region”, but only gives a cursory reference to Figure 4, below.

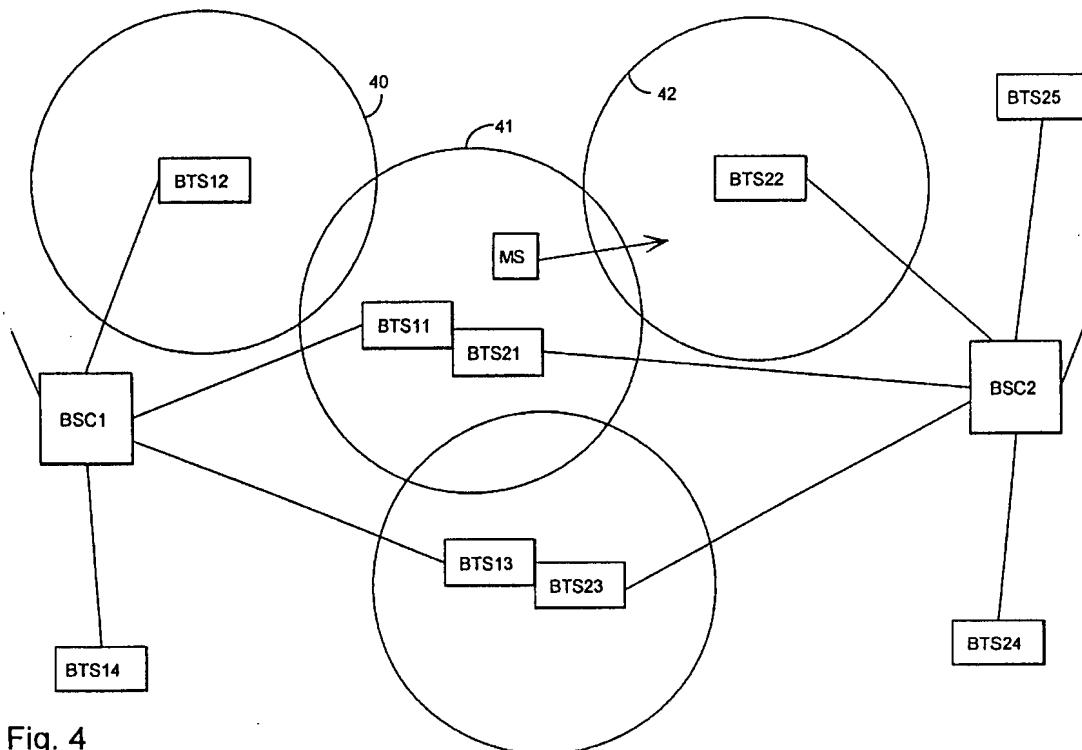


Fig. 4

Jolma does not describe any part of this figure as a hard handoff region. The Examiner's cursory reference cannot support a *prima facie* anticipation rejection. As there is not suggestion or motivation to modify Jolma to include this feature, there can also be no proper obviousness rejection over Jolma.

The Examiner responds has argued that a limitation

...it is an inherent feature, and/or an obvious expedient thereof, that to perform a successful hard handoff for a mobile station between two base transceiver stations in different networks, such mobile station must reach a border of a hard handoff region or must be located in the hard handoff region. Once it is determined that he mobile station is in a hard handoff region, the base station controller decides, among other things, whether the hard handoff should occur, to which base station, and/or when it should occur.

The Examiner's reasoning is partially correct. It is of course true that a hard handoff only occurs when a mobile station is located in a region capable of hard handoffs – that is, a hard handoff can occur when the mobile station is in a place in which it is possible for the hard handoff to occur. The Examiner's reasoning is reflected in the claims as amended, where the hard handoff is performed when the mobile station has reached a hard handoff region. Still, Jolma does not include any specific teaching of a "hard handoff region".

The independent claims are also amended to specify that the hard handoff occurs when a hard handoff threshold has been exceeded, as described in the specification. This feature is not taught or suggested by Jolma.

As the current claims describe a specific conditions under which a hard handoff is made, and this feature is not taught or suggested by any art of record, all claims distinguish over all art of record.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 rejections with respect to all claims.

CLAIM REJECTIONS -- 35 U.S.C. § 103

Claims 5, 10 and 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jolma. The Applicant respectfully traverses the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October

2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

As each of these claims depends from an independent claim including limitations not taught or suggested by any art of record, as described above, all claims distinguish over all art of record.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 103 rejection with respect to these claims.

CONCLUSION

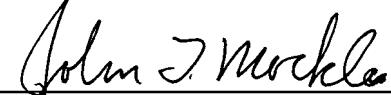
For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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